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10/585,727	03/17/2007	Thomas Guthner	7601/88230	7880

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LAW OFFICE OF MICHAEL A. SANZO, LLC  
15400 CALHOUN DR.  
SUITE 125  
ROCKVILLE, MD 20855

EXAMINER
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BALASUBRAMANIAN, VENKATARAMAN

ART UNIT	PAPER NUMBER
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1624

MAIL DATE	DELIVERY MODE
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08/12/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### **ADVISORY ACTION**

The applicants' response, filed 7/21/2008 under 37 CFR 1.116 in reply to the final rejection has been considered but not entered as it is not deemed to place the application in condition for allowance for the following reasons.

The 103 rejection made in the previous office action is maintained.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 21-39 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stucky US 5,663,340 in view of Daluge US 6,552,193 for reasons of record.

Applicants' traversal is not persuasive. Applicants have argued that instant process is distinct over the prior art process in that it does not entail isolation of the intermediate.

However, carrying out the prior art process without isolation of an intermediate is within the skill set of one trained in the art and one trained in the art would be motivated carry out the process with isolation or without isolation of the process. In addition, prior art clearly shows the process can be done in one-pot. See example 2 of Stucky, column 5 & 6.

Applicants have argued that the purity of instant process is better than the prior art process. However, reading examples 1 and 2 and then comparative example 3, it is not clear such is the case.

Furthermore, applicants have not made proper comparison and the experimental conditions in example 3 appear to be different from those of examples 1 and 2. Again, the comparison is not made with the applied prior art conditions.

Note Ex parte Gelles 22 USPQ 2nd 1318, especially the following quote: " The evidence relied upon also should be reasonably commensurate in scope with the subject matter claimed and illustrate the claimed subject matter " as a class" relative to prior art subject matter."

Again, note In re KSR International vs. Teleflex Inc., 82 USPQ2d 13-85, 1397 (2007), the court stated that

[w]hen there is a design need or market pressure to solve a problem and there are a finite number of identified, predictable solutions, a person of ordinary skill has good reason to pursue the known options within his or her technical grasp. If this leads to the anticipated success, it is likely the product not of innovation but of ordinary skill and common sense.

Such is the case with instant claims. Both the prior art cited above taken together teach the overall process for making 2-amino-4,6-dichloro-5-foramidopyrimidine including use of no solvent in the first step, appropriate temperature and pH in the aqueous hydrolysis step. While stated prior art use aqueous acid or phosphate buffer with pH adjustment, instant process adds water and neutralizes the phosphoric acid of

the first step with base to arrive at the pH range. Both the prior art and instant process use aqueous condition for hydrolysis (as in Daluge). Hence, based on the teaching which provide guidance to choose various process limitations stated above, one trained in the art would be motivated to make compounds using the process including optimizing some of these limitations. Such an optimization is within the skill set of one trained in the art. Hence, such optimization would be not innovation but of ordinary skill and common sense as noted by the court.

Hence, this rejection is proper and is maintained.

#### ***Conclusion***

Any inquiry concerning this communication from the examiner should be addressed to Venkataraman Balasubramanian (Bala) whose telephone number is (571) 272-0662. The examiner can normally be reached on Monday through Thursday from 8.00 AM to 6.00 PM. The Supervisory Patent Examiner (SPE) of the art unit 1624 is James O. Wilson, whose telephone number is 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned (571) 273-8300. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAG. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you

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have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-2 17-9197 (toll-free).

/Venkataraman Balasubramanian/

Primary Examiner, Art Unit 1624